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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Warren D.W. Heston et al.

Serial No.: 10/614,625 Group Art Unit: 1649

Filed: July 2, 2003 Examiner: C. Borgeest

For: PROSTATE-SPECIFIC MEMBRANE ANTIGEN AND USES THEREOF

1185 Avenue of the Americas
New York, New York 10036
July 24, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO JANUARY 23, 2006 OFFICE ACTION AND PETITION FOR FIVE-MONTH EXTENSION OF TIME

This Communication is submitted in response to the January 23, 2006 Office Action issued in connection with the above-identified application. A response to the January 23, 2006 Notice was due February 23, 2006. Applicants hereby petition for a five-month extension of time. The fee for a five-month extension of time is ONE THOUSAND AND EIGHTY DOLLARS ($1080.00), and a check for this amount is enclosed. With a five-month extension of time a response is now due July 23, 2006. However, since July 23, 2006 falls on a Sunday, a response filed on the next succeeding day which is not a Saturday, Sunday or Federal Holiday, i.e. Monday, July 24, 2006, is considered timely under 37 C.F.R. §1.7. Accordingly, this Communication is being timely filed.

Restriction Requirement Under 35 U.S.C. §121

In the January 23, 2006 Office Action, the Examiner stated that restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 24-25, drawn to a method comprising administration of an inhibitor of glutamate release by N-acetylaspartylglutamic acid (NAAG) hydrolysis;
II. Claims 25-32 and 35, drawn to a composition comprising a NAALADASE inhibitor and a carrier; and.
III. Claims 33-34, drawn to a composition comprising a NAALADASE inhibitor and a carrier and at least one additional therapeutic agent.

In addition, further to a February 6, 2006 telephone conference between Examiner Christina Borgeest and Brian Amos of the undersigned's office, Examiner Borgeest stated that pending claim 26 was also included within claim Group II.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Group I, drawn to a method comprising administration of an inhibitor of glutamate release by N-acetylaspartylglutamic acid (NAAG) hydrolysis.

The Examiner additionally required that if applicants elected Group I that they should also elect one of the following species for further prosecution to which the claims shall be restricted if no generic claim is finally held allowable:

a) $Mtxglu_3$
b) $pteglu_3$
c) $pABAglu_5$

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's species a), i.e. Mtxglu$_3$.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-III are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect…".

Group I provides therapeutic methods involving the inhibition of PSMA enzyme activity, and Groups II and III provide related compositions. Accordingly, the inventions of Groups I-III are not independent.

Applicants also point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of

prior art with regard to Group II would identify art for Group III, since Group II is drawn to a composition comprising a NAALADASE inhibitor and a carrier, and Group III is drawn to the same composition excepting that it comprises at least one additional therapeutic agent. Since there is no serious burden on the Examiner to examine Groups II-III in the subject application, the Examiner must examine both of these groups on the merits.

No fee, apart from the enclosed $1080.00 fee for a five-month extension of time, is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

Respectfully submitted,

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